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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/978,564	10/16/2001	Avi J. Ashkenazi	GNE.2630P1C25	5282
35489	7590	02/22/2006	EXAMINER	
HELLER EHRMAN LLP 275 MIDDLEFIELD ROAD MENLO PARK, CA 94025-3506			ANGELL, JON E	
			ART UNIT	PAPER NUMBER
			1635	

DATE MAILED: 02/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/978,564

Applicant(s)

ASHKENAZI ET AL.

Examiner

Jon Eric Angell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2005 and 30 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 58-62 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 58-62 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/29/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Action is in response to the communications filed on 9/29/2005 and 11/30/2005.

The amendment(s) filed 9/29/2005 and 11/30/2005 are acknowledged. The amendment has been entered. Claims 58-62 are currently pending in the application and are addressed herein.

Applicant's arguments are addressed on a per section basis. The text of those sections of Title 35, U.S. Code not included in this Action can be found in a prior Office Action. Any rejections not reiterated in this action have been withdrawn as being obviated by the amendment of the claims and/or applicant's arguments.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 9/29/2005 is acknowledged. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 58-62 remain rejected under 35 U.S.C. 103(a) as being unpatentable over US 2002/0055139 A1 (**HOLTZMAN** et al., published May 9, 2002 with priority to 09/312359, filed May 14, 1999) for the reasons of record set forth in the 6/29/2005 Office Action.

Response to Arguments

Applicant's arguments filed 9/29/2005 have been fully considered but they are not persuasive. Additionally, the Declaration filed on 11/30/2005 under 37 CFR 1.131 has been considered but is ineffective to overcome the Holtzman et al. reference (U.S. 2002/0055139).

Applicants acknowledged that the Holtzman et al. reference teaches a polypeptide (A236) that is 1005 identical to SEQ ID NO: 59. However, Applicants argue that they were in possession of the PRO363 polypeptide prior to May 14, 1999. Applicants have submitted a Declaration under 37 CFR 1.131 to show that they were in possession of the SEQ ID NO: 59 sequences prior to May 14, 1999. Applicants also refer to the "Stempel Doctrine" and argue that

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an applicant need only show that portion of his or her claimed invention that appears in the cited reference.

Regarding the “Stempel Doctrine” Applicants are respectfully reminded that MPEP § 715.03 indicates that the test is whether the facts set out in the affidavit are such as would persuade one skilled in the art that the applicant possessed so much of the invention as is shown in the reference or activity. In re Schaub, 537 F.2d 509, 190 USPQ 324 (CCPA 1976).

In the instant case, the evidence submitted does not show that the applicant possessed so much of the invention as is shown in the reference. Specifically, the submitted evidence shows that Applicants had possessed the sequence of SEQ ID NO: 59 and had also determined that the sequence had homology to HCAR, as is taught by the HOLTZMAN et al. reference. However, the evidence submitted is not as much of the invention as is shown in the reference because HOLTZMAN also teaches that the A236 sequence (which is identical to the claimed PRO363 sequence) is expressed in a number of specific tissues including: brain, placenta, uterus, ovaries, intestinal tract and the heart (e.g., see paragraph [0337]). Furthermore, Holtzman also teaches expression of the A236 polypeptide in 293T cells, which does not appear to be taught in the evidence presented. Therefore, the evidence submitted by Applicants does not show that the applicant possessed so much of the invention as is shown in the reference, as is required by the Stempel Doctrine.

It is respectfully pointed out that a prior showing that is equal to that of the Holtzman et al. reference would be sufficient to overcome the rejection. Alternatively, a prior showing that exceeds that of the reference, such as a showing that the chondrocyte differentiation assay was completed prior to May 14, 1999 would also be sufficient to overcome the rejection. However,

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since the evidence presented does not show the applicant possessed so much of the invention as is shown in the reference, the evidence presented is not persuasive and the rejection is maintained.

Conclusion

No claim is allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jon Eric Angell whose telephone number is 571-272-0756. The examiner can normally be reached on Mon-Fri, with every other Friday off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on 571-272-0811. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Anne-Marie Falk
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PRIMARY EXAMINER